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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/812,627
Filing Date: March 20, 2001
Appellant(s): LAWRENCE ET AL.

MAILED

DEC 03 2007

GROUP 3600

Randolph P. Calhoun
(Reg. No. 45,371)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on October 4, 2007 appealing from the Office action mailed on February 22, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|-----------------|--------|
| 6,119,103 | BASCH et al. | 9-2000 |
| 7,006,992 B1 | PACKWOOD, T. R. | 2-2006 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7-21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basch et al. (US Patent 6,119,103) in view of Packwood (US Patent 7,006,992 B1).

Claims 1, 16 and 21 Basch teaches a computer-implemented method, a computerized system, a computer executable program code residing on a computer readable medium for managing risk related to a financial transaction, the method comprising: gathering data into a computer storage, the data related to risk variables for a financial transaction (See Basch Abstract, Figure 1 and claims 1, 2); receiving information into the computer storage relating to details of a financial transaction (See Basch Abstract, Figure 1 and claims 1, 2, 19 and 29); structuring the received information received with a processor, according to a risk quotient criteria associated with at least one risk (See Basch Abstract, Figure 1 and claims 1-7); and generating with the processor, a risk quotient comprising at least one of a scaled numeric value and a scaled alphanumeric value based on the structured information and the gathered data (See Basch Abstract, Figure 1 and claims 1, 2, 19 and 29). The risk score is interpreted to include a risk quotient and the score is interpreted to include at least one of a scaled numeric value and a scaled alphanumeric value. Communication network, executable software stored on the server and executable on demand are inherent in the disclosure of Basch.

Basch does not teach the step wherein the risk is at least one of a legal, regulatory, and reputational risk.

Packwood teaches the step wherein the risk is at least one of a legal, regulatory, and reputational risk (See Packwood Column 10 line 60 – Column 11 line15).

It would have been obvious to one with ordinary skill in the art at the time of invention to include the step wherein the risk is at least one of a legal, regulatory, and reputational risk to the

disclosure of Basch. The combination of the disclosures taken as a whole suggests that it would have helped the user identify otherwise undetected risks and aid in the overall management of an enterprise (See Packwood Column 3 lines 44-49).

Claim 2, Basch teaches the step of generating a suggested action responsive to the risk quotient (See Basch claim 1). The step of transmitting the score to an account issuer based on the score is interpreted to include the step of generating a suggested action responsive to the risk quotient.

Claim 3, Basch teaches the steps of storing the information received, the risk quotient and the suggested action; and generating a diligence report referencing the stored information. (See Basch claims 3-7 and Column 10 lines 24- 32 and 55-60) The reports are interpreted to include diligence reports also.

Claim 4, Basch teaches the step wherein the diligence report comprises the information received relating to details of the financial transaction and actions taken responsive to the risk quotient. (See Basch Column 13 lines 26-62) The format of the alerts and reports are interpreted to include details of the financial transaction and actions taken responsive to the risk quotient.

Claim 5, Basch teaches the step wherein the suggested action is additionally responsive to the information received. (See Basch Column 8 lines 2-12). The dispute action is interpreted to include action is additionally responsive to the information received.

Claim 7, Basch teaches the step wherein the suggested action comprises refusing to perform a transaction. (See Basch claim 6). Denying authorization request is interpreted to include the step of refusing to perform a transaction.

Claim 8, Basch teaches the step wherein the suggested action comprises refusing to perform a transaction. (See Basch claim 6 and Column 11 lines 3-5). The step of refusing to perform a transaction is interpreted to include the step of blocking acceptance of an account.

Claim 9, Basch teaches the step wherein the suggested action comprises notifying an authorized private or public data services. (See Basch Column 9 line 62 - Column 10 line 3) The authorized private or public data services are interpreted to include an authority.

Claim 10, Basch teaches the step wherein the information received comprises the identity of a high-risk entity and the high-risk entity's relationship to an account holder. (See Basch Column 12 lines 47-52 and Column 13 lines 40-49)

Claim 11, Basch teaches the step wherein the information received comprises the identity of public agencies. (See Column 6 lines 24- 31) The public agencies are interpreted to include a secrecy Jurisdiction.

Claim 12, Basch teaches the step wherein the information received is gathered electronically. (See Basch Column 8 lines 20-22 and Column 8 line 60 -Column 9 line 10)

Claim 13, Basch teaches the step of aggregating risk quotients relating to a financial institution to assess a level of identified risk to which the financial institution is exposed. (See Basch Column 5 line 62 -Column 6 line 8).

Claim 14, Basch teaches the step wherein scores are generated for transactions. (See Basch Column 17 lines 9-11) The scores are interpreted to include an average risk quotient associated with a transaction.

Claim 15, Basch teaches the step wherein the financial transaction comprises opening a financial account. (See Basch Column 11 lines 3-5).

Claim 17, Basch teaches a system wherein the information is received via an electronic feed. (See Basch Column 8 lines 20-22 and Column 8 line 60 -Column 9 line 10)

Claim 18, Basch teaches a system wherein the information received is generated by a public agency. (See Column 6 lines 24- 31) The public agencies are interpreted to include a government agency also.

Claims 19, 20 and 26, Basch fails to explicitly teach the steps wherein the network access device is a personal computer or a wireless handheld device and the risk quotient is indicative of an amount of money to defend an adverse position or a fine.

Official notice is taken that using a personal computer and/or a wireless handheld device to access networks are old and well known in the art. These devices allow the user to efficiently and rapidly communicate with the network. Also risk ratings indicative of liability risk (which includes an amount of money to defend an adverse position or a fine) are old and well known. These ratings help an insurer determine the premiums for underwriting the risk and for a user to determine if the risk is worth insuring.

It would have been obvious to one with ordinary skill in the art at the time of invention to include a personal computer and/or a wireless handheld device to the disclosure of Basch. The combination of the disclosures taken as a whole suggests that it would have helped the user facilitate faster and more efficient communication with the network and also determine if the risk is worth insuring.

(10) Response to Argument

In response to Appellant's argument that Basch fails to disclose or suggest a risk quotient criteria associated with at least one of a legal, regulatory, and reputational risk, the examiner

would like to point out that Basch is not relied on to teach this feature. Packwood teaches the step wherein the risk is at least one of a legal, regulatory, and reputational risk (See Packwood Column 10 line 60 – Column 11 line15). As noted by the Appellant on page 6 of the brief, Packwood identifies three hundred risk factors including latest compliance regulatory exam rating, open audit and regulatory findings over twelve months old which are examples of regulatory risk. Packwood also identifies factors such as legal risk self-assessment which are examples of legal risk. Further in Column 12 lines 35-67, Packwood discloses quantifying risk factors both numerically and by a non-numeric value, which is interpreted as at least one of legal, regulatory, and reputational risks associated with a risk quotient criteria. Therefore, Packwood clearly discloses at least one of legal, regulatory, and reputational risks associated with a risk quotient criteria.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one with ordinary skill in the art at the time of invention to modify Basch to include the teachings of Packwood. The combination of the disclosures taken as a whole suggests that it would have helped the user identify otherwise undetected risks and aid in the overall management of an enterprise. The motivation to combine can be found in Packwood (See Packwood Column 3 lines 44-49).

In response to Appellant's assertion "Appellant respectfully submits that even if Basch and Packwood were combined as asserted in the FOA, the resulting Basch/Packwood combination would not render the claims obvious", the examiner would like to point out that *KSR (KSR International Co. v Teleflex Inc., 550 U.S.-, 82 USPQ2d 1385 (2007))* forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness.

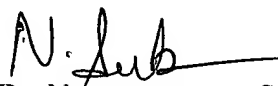
Applicant's other arguments with respect to pending claims have been considered but are not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

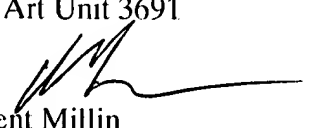
Respectfully submitted,


Dr. Narayanswamy Subramanian
Primary Examiner, Art Unit 3691

November 28, 2007

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